

### REMARKS

Claims 1-8 and 19-20 stand rejected. No changes to the claims are presented in this Response. Thus, Claims 1-8 and 19-20 are pending in the application.

#### Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

Independent Claims 1 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,987,611 to Freund et al. in view of U.S. Patent Number 6,839,680 to Liu. Applicant respectfully disagrees. However, as Applicant has filed with this response Declarations by the inventors and patent attorney, under 37 C.F.R. § 1.131 that Applicant believes removes the Liu reference from consideration, Applicant has not presented arguments in support of the patentability of these claims.

The *Declarations* include facts showing conception of the invention in this country before the filing date of the parent application. The showing of facts are such, in character and weight, as to establish conception of the invention prior to the effective date of the Liu reference coupled with due diligence from a date prior to the effective date of the Liu reference to a subsequent filing of the parent application.

Applicant notes that Liu was filed on September 30, 1999. The critical date to remove the Liu application from consideration is thus September 30, 1999. The features of the invention as recited in Claims 1-8 and 19-20 were conceived at least prior to September 30th in this country. The *Declaration* by the inventors, John Carrington, Ronald Hegli and David Oei, shows that a paper describing the invention was created prior to September 30, 1999. Applicant submits that the paper shows conception of the claimed invention prior to the critical date. These facts establish that the inventors had conceived of the invention as early as September 30, 1999.

Additionally, reasonable due diligence in reducing the invention to constructive reduction to practice was made from at least prior to September 30, 1999 to at least January 28, 2000, the filing date of the parent application to the present patent application. The facts in the *Declarations* show that the invention was diligently reduced to practice therefrom until the filing of the parent application (U.S. Patent Serial No. 09/494,315) of the present application on January 28, 2000. In addition, the diligence of the attorney in preparing and filing the patent application inures to the benefit of the inventor. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application

during the continuous critical period. It is not necessary that the attorney should drop all other work and concentrate on the particular invention involved. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.). The *Declaration* by Mr. Fuller shows that he met the requisite diligence with respect to progress on the application during from at least his meeting with Ron Hegli on October 22, 1999 to filing the parent patent application on January 28, 2000. Applicant has included Exhibits 1 and 2 to the Inventor Declaration and Appendices A, B, and C to the Fuller Declaration, which corroborate the declarations to show conception prior to September 30, 1999 and diligent reduction to practice therefrom.

Consequently, Applicant respectfully submits that Liu is not available as a prior art reference under 35 U.S.C. § 103(a). Furthermore, since Liu was relied upon in the Office Action, Applicant respectfully submits that the Examiner has failed to provide a valid prima facie rejection. Accordingly, Applicant submits that each of Claims 1-8 and 19-20 is in condition for allowance.

#### CONCLUSION

For the foregoing reason, it is respectfully submitted that the rejection set forth in the outstanding Office Action is inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain of if an issue requires clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve any such issue promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

James F. Herkenhoff  
Registration No. 51,241  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550